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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,136	03/23/2005	Federico Stroppolo	3504-0104	2562
6449 7590 11/13/2009 ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005				
EXAMINER				
PICKETT, JOHN G				
ART UNIT		PAPER NUMBER		
3728				
NOTIFICATION DATE		DELIVERY MODE		
11/13/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary

Application No.

10/529,136

Applicant(s)

STROPPOLO ET AL.

Examiner

J. Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6, 8 and 9 is/are allowed.
- 6) ☒ Claim(s) 7 and 10-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The response filed 2 July 2009 is acknowledged. Claims 6-17 are pending in the application. Claims 1-5 have been canceled.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. In reviewing the prosecution history of this application, it is noted that a several critical aspects of the claimed invention have not been addressed in previous Official Actions. The amendment of 21 September 2006 presented all new claims that brought in several features to the claimed invention; features that appear to lack support in the original disclosure. In order to give applicant adequate opportunity to respond to these new issues, this Office Action is made **NON-FINAL**.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The “generally rectangular” shape and recessed “compartment” recited in claims 6 and 12.

The matrix with tabs formed in the center portion and contiguous tabs of claims 8 and 14.

The width greater than or equal to one half the width of the corresponding spaced apart section of claims 7 and 12.

The substantially parallel widths of claims 9 and 15.

Claim Objections

4. Claims 10, 11, 16, and 17 are objected to because of the following:

The claims add perforations to a closed parent claim. The transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931). A claim which depends from a claim which "consists of" the recited elements or steps cannot add an element or step. See MPEP 2111.03

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. Claims 7 and 10-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 7 and 12 recite a width that is greater than or equal to one half a width of the spaced apart sections. Applicant appears to be relying on the figures to find support for this limitation, but it must be noted that the drawings are not disclosed as "to scale",

and there is no description of the range. It is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue. See *Hockerson-Halberstadt, Inc. v. Avia Group Int 'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000).

Claims 13-17 are dependent upon claim 12 and are rejected for the above reasons.

In claims 10, 11, 16, and 17, the original disclosure recites perforations or cuts 18, but appears to provide no support for perforations on the tabs; accordingly, the limitations constitute impermissible new matter. The critical passage in the original disclosure is found on page 4, where it recites, "the tabs 20 may be cut in a number of different ways to ease to ease manufacturing time and minimize materials." Support for a cut does not equate to support for perforations and certainly not for perforations corresponding to each tab as recited in the claims. Further, there appears to be no support for a first edge of the tab portion being extended along a first or second outer side. The drawings themselves appear to be insufficient to provide support for perforations.

Double Patenting

6. Applicant is advised that should claim 7 be found allowable, claim 12 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both

cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Allowable Subject Matter

7. Claims 6, 8, and 9 appear to define over the available prior art and are allowed.
8. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

9. Applicant's arguments with respect to the enablement rejection (particularly the "fixed in part" to the upper surface, are persuasive. Upon reading the original disclosure it appears that the perforations are not critical features in the invention. As pointed out by the applicant, the sheet need merely be "fixed in part" to form the tabs. For a part to be critical, it must be taught as such in the specification. See *In re Mayhew*, 527 F.2d 1229, 1233, 188 USPQ 356, 358 (CCPA 1976).

However, with respect to the objections due to the "consisting of" transitional phrase, the transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. In *re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931). The examiner contends that the perforations are additional **elements** since they are not

previously defined in the claim and their presence dramatically alters the arrangement of the device (see functional descriptions in claims 10, 11, 16, and 17).

Further, with respect to the Double-Patenting warning, claim 6 only states that a length is present in a certain direction. Any three-dimensional object will have a length, width and height and such a length would inherently be found in claim 12. Claim 6 recites nothing more to distinguish the length with respect to any of the other claimed structures. Therefore, the inclusion of this feature does not substantially distinguish claims 7 and 12.

Conclusion

10. As the examiner is raising new issues, this Office Action is made **NON-FINAL**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. Gregory Pickett/
Primary Examiner, Art Unit 3728